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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,439	01/14/2005	Michio Mineshima	NPR-159	9055

7590  
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11/01/2007

EXAMINER
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KOHARSKI, CHRISTOPHER

ART UNIT	PAPER NUMBER
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3763

MAIL DATE	DELIVERY MODE
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11/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/521,439

Applicant(s)

MINESHIMA ET AL.

Examiner

Christopher D. Koharski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Examiner acknowledges the reply filed 8/09/2007 in which claims 1 and 7 were amended. Currently claims 1-2 and 4-11 are pending for examination in this application.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: Claim 1 should read "...characterized in that a means capable...". Appropriate correction is required.

Examiner also requests Applicant remove the word "characterized" to better conform with United States patent claims drafting practice.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 4-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacobsen et al. (5,141,493). Jacobsen et al. discloses a closed circuit peritoneal dialysis system.

Regarding claims 1-2 and 4-11, Jacobsen et al. discloses a peritoneal dialysis system (Figures 1A-1B) comprising: a catheter (12) capable of injecting and discharging peritoneal dialysate in an abdominal cavity of a patient (patient, Figure 1A); a peritoneal dialysate circuit (primary circuit) external of the patient connected to the catheter (12);

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and a dialyzer provided in the peritoneal dialysate circuit (primary circuit, 1A); said dialyzer comprising a hemodialysate circuit (secondary circuit, 1B) connected via a hollow fiber membrane (24), characterized in that a means capable (196, 160, 28) of measuring a conductive osmotic agent concentration in peritoneal dialysate is provided in the peritoneal dialysate circuit on the side of the end at which the catheter (12) is connected for removal of water in the peritoneal dialysis circuit (cols 4-5) using microprocessor (220) controlled pumps (192, 16, 72) (Figures 1A-1B) with a calculating unit (cols 6-7) (Figure 1).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-2 and 4-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Noack (US2002/0107474). Noack discloses a method for determining the intraperitoneal volume and device for peritoneal volume and a device for peritoneal dialysis.

Regarding claims 1-2 and 4-11, Noack discloses a peritoneal dialysis system using glucose and albumin as osmotic agents ([003, 0012]) (Figure 1) comprising: a catheter (1) capable of injecting and discharging peritoneal dialysate in an abdominal cavity of a patient (P, Figure 1); a peritoneal dialysate circuit (19) external of the patient connected to the catheter (1); and a dialyzer (8) provided in the peritoneal dialysate circuit (19); said dialyzer comprising a hemodialysate circuit (20) connected via a hollow fiber membrane (8), characterized in that a means capable (10) of measuring a conductive osmotic agent concentration in peritoneal dialysate is provided in the peritoneal dialysate circuit on the side of the end at which the catheter (1) is connected for removal of water in the peritoneal dialysis circuit (cols 1-2) using microprocessor (22) controlled pumps (9, 18, 16) with a calculating unit ([0028-0036]) (Figures 2A-2C) (Figure 1).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-2 and 4-11 have been considered but are moot in view of the new ground(s) of rejection (see above).

***Suggested Allowable Subject Matter***

The following claim subject matter is suggested by the examiner and considered to distinguish patentably over the art of record in this application and is therefore presented to Applicant for consideration:

Examiner suggests adding specific limitations to the dehydration mechanism (6) or drawn to the methodology of the dehydration system that differentiates from a conventional osmotic pressure differential system that removes water as a by-product of the process.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: See PTO-892 (x4).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on 7:30am to 4:00pm EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date:

10/27/07

  
NICHOLAS D. LUCCHESI  
SUPERVISORY PATENT EXAMINER  
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